

### **REMARKS**

Claims 8-14 stand rejected. New Claims 15-18 have been added. Claim 8 has been amended. Claims 8-18 are therefore pending in this application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

#### **1. Rejection of Claim 8-14 (35 U.S.C. § 103(a))**

Claims 8-14 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,499,022 (Boschini) in view of U.S. Patent No. 6,496,100 (Hiebl). Applicants submit that the rejections should be withdrawn for at least the following reasons.

Boschini describes a method of keyless locking of a motor vehicle including a transponder (badge) and a transceiver. The transceiver, installed on-board the vehicle, identifies the position of the transponder either by measuring a signal strength at different instants (col.5, lines 64-67) or by employing an internal antenna 60 mounted inside the vehicle (col.6, lines 33-45). If the transponder is found to have been forgotten inside the vehicle, the doors are unlocked (col.6, lines 1-3) or the locking is prevented entirely (col.6, lines 33-45). Hiebl describes a remote keyless entry system that allows the locking of a vehicle to prevent theft of the same.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the prior art references must not only teach or suggest all the claim limitations, but also *suggest combining the elements* in the manner contemplated by the claim. M.P.E.P. § 2143.01. Claim 8, as currently amended, recites “activating the closing system by locking the closing system when the at least one operating element is actuated again *after activation of the at least one display arrangement, independently of the position of the transponder*” (emphasis added). It is observed in the Office Action that Hiebl teaches “activating the closing system by locking the closing system when the user leaves the vehicle.” It is further suggested by the Examiner that it would be obvious to one skilled in the art that “this closing operation is the second operation followed *after the retrieving the transponder left in the vehicle*” (emphasis added). It appears that the Examiner is merely stating that Boschini suggests that the transponder should be retrieved before the locking can be attempted again. However, this would amount

to a simple *repetition of the entire locking process* after a problematic condition (forgotten transponder) has been discovered. On the other hand, the activation of the closing system of amended Claim 8 is a confirmation of the fact that a user really intends to lock the vehicle, “independently of the position of the transponder.” As recited in amended Claim 8, the locking occurs “after activation of the at least one display arrangement,” *even though the transponder may still be in the vehicle*. “The user must thus be active again to perform the locking. It is thus assumed that although the user is aware of the critical transponder position, he is willing to actively take it into account.” (Substitute specification, page 5, lines 14-16.) Applicants respectfully submit that no suggestion is present in either Boschini or Hiebl to perform the locking operation of Hiebl after the process described by Boschini has resulted in the activation of the display arrangement. For at least these reasons, Claim 8 and its dependent claims 9-14 are allowable over Boschini and Hiebl.

Furthermore, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. M.P.E.P. § 2141.02. Boschini discusses a detailed handshaking sequence to detect that the badge has been forgotten inside the vehicle (col.6, lines 52-67; col.7, lines 1-38). Many steps of the procedure, including a timing step (col.7, lines 39-47), give the driver *time to recover the badge* before the badge is deactivated. As is confirmed even by the Examiner’s reading of the references, such teaching would certainly lead a person with ordinary skills in the art *not* to pursue an explicit confirmation of the locking as claimed in Claim 8.

Based on the foregoing remarks, Applicants traverse the combination of Boschini and Hiebl, which is based on improper hindsight reconstruction, rather than on a suggestion from the references that is “clear and particular.” *In re Dembiczak*, 50 2d 1614 (Fed. Cir. 1999). Applicants therefore submit that Claim 8 and its dependent Claims 9-14 are allowable.

Independent of the above, Claim 9 recites a method wherein “the closing system is activated to lock the motor vehicle so that a vehicle door can be opened only by at least one internal operating element in the interior of the motor vehicle.” Boschini discusses a method for detecting the presence of a transponder (badge) inside a vehicle at the time of locking the doors. If the badge is found to be inside the vehicle, the doors are unlocked (col.7, lines 18-21). Boschini does not discuss the opening of a door from the interior of the vehicle and does

not teach or suggest this limitation of Claim 9. The identical remark applies to Claims 10 and 11. Applicants respectfully request withdrawal of the rejections of Claims 9-11, for these additional reasons.

Claim 13 recites “storing additional information in a memory on deactivation of the transponder located in the interior of the motor vehicle.” This memory may include additional data such as time and kilometer reading, and may be used for example, for insurance purposes (specification, page 3, lines 4-6). In contrast, Boschini discusses a generic deactivation of the badge (col.7, lines 29-31), and does not teach or suggest storing information in a memory on deactivation of the transponder located in the vehicle, nor would this be obvious to a person of ordinary skill in the art. Therefore, Applicants respectfully request withdrawal of the rejection of Claim 13 for this additional reason.

Claim 14 recites a method wherein “an activation of the transponder that has been deactivated occurs on unlocking the closing system” (emphasis added). In contrast, Boschini generally discusses a method including *deactivation* of the badge. Re-activation is not taught or suggested by Boschini, nor would it be obvious to a person of ordinary skill in the art. Therefore, Applicants respectfully request withdrawal of the rejection of Claim 14 for this additional reason.

For at least the foregoing reasons, Applicants submit that Claims 8-14 are allowable, and respectfully request that all the rejections be withdrawn.

## **2. New Claims 15-18**

To claim further aspects of the present invention, new Claims 15-18 have been added. The newly added claims are supported throughout the original disclosure. No new matter has been added.

In particular, Claim 15 recites “activating the at least one display arrangement when the transponder is on a side of the motor vehicle opposite the actuated at least one operating element.” Boschini describes a system which relies on a central antenna 60 to detect that the badge has been forgotten inside the vehicle (col.6, lines 33-45). Such symmetrical design, which relies on a centrally positioned internal antenna 60, ignores the possibility that, for example, a passenger may mistakenly hold the transponder on a side of the vehicle opposite

Appl. No. 10/009,670  
Attorney Docket No. 10191/1949  
Reply to Office Action of July 16, 2004

the actuated operating element (which may be, for example, the side opposite the driver who is locking the vehicle). In fact, Boschini suggests that if the transponder is detected in zones 71' and 74' (outside, passenger side) the locking may be normally performed (col.6, lines 28-32; col.6, lines 46-51).

Claims 16-18 ultimately depend from Claim 8 and are allowable for at least the same reasons.

Appl. No. 10/009,670  
Attorney Docket No. 10191/1949  
Reply to Office Action of July 16, 2004

**CONCLUSION**

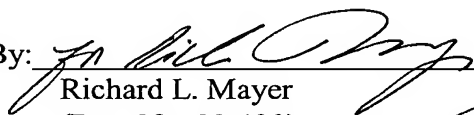

In view of the above amendments and remarks, it is respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

The Office is authorized to charge any fees associated with this Amendment to Kenyon & Kenyon Deposit Account No. 11-0600.

Respectfully Submitted,

KENYON & KENYON

Dated: November 5, 2004

By:  (by  
Richard L. Mayer  
(Reg. No. 22,490)  
  
# - no.  
36,197)

One Broadway  
New York, NY 10004  
(212) 425-7200

**CUSTOMER NO. 26646**